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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,935	01/18/2006	Prakash Patel	056258-5124	4053
9629	7590	06/28/2006	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			KLEMANSKI, HELENE G	
			ART UNIT	PAPER NUMBER

1755

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/564,935	Applicant(s) PATEL, PRAKASH	
	Examiner Helene Klemanski	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/18/06</u> | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The references cited in the Search Report dated September 20, 2004 have been considered.

### ***Claim Objections***

2. Claim 3 is objected to because of the following informalities: in claim 3, the twelfth line after the phthalocyanine nucleus, a comma should be inserted between the terms "source" and "a". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 2 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2 and 26, the phrase "in the presence of a suitable nitrogen source (if required)" is considered vague and indefinite because it is unclear whether the limitations preceding the phrase are part of the claimed invention. See MPEP 2173.05(d). The use of this phrase suggests that the claimed composition may be produced to the desired end product with or without the inclusion of those components (i.e. limitations). Therefore, one must resort to conjecture to ascertain applicants

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intended point. The examiner suggests the deletion of the term "(if required)" and adding the phrase "optionally in the presence of a suitable nitrogen source" in its place to overcome the rejection.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/564,958. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are generic to said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

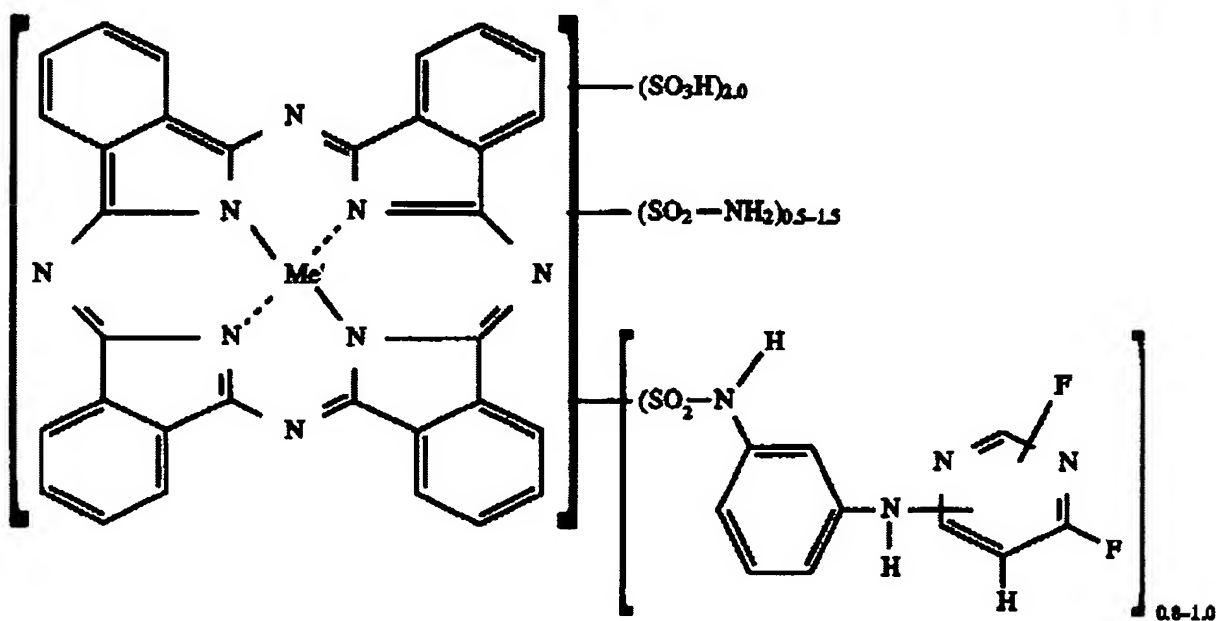
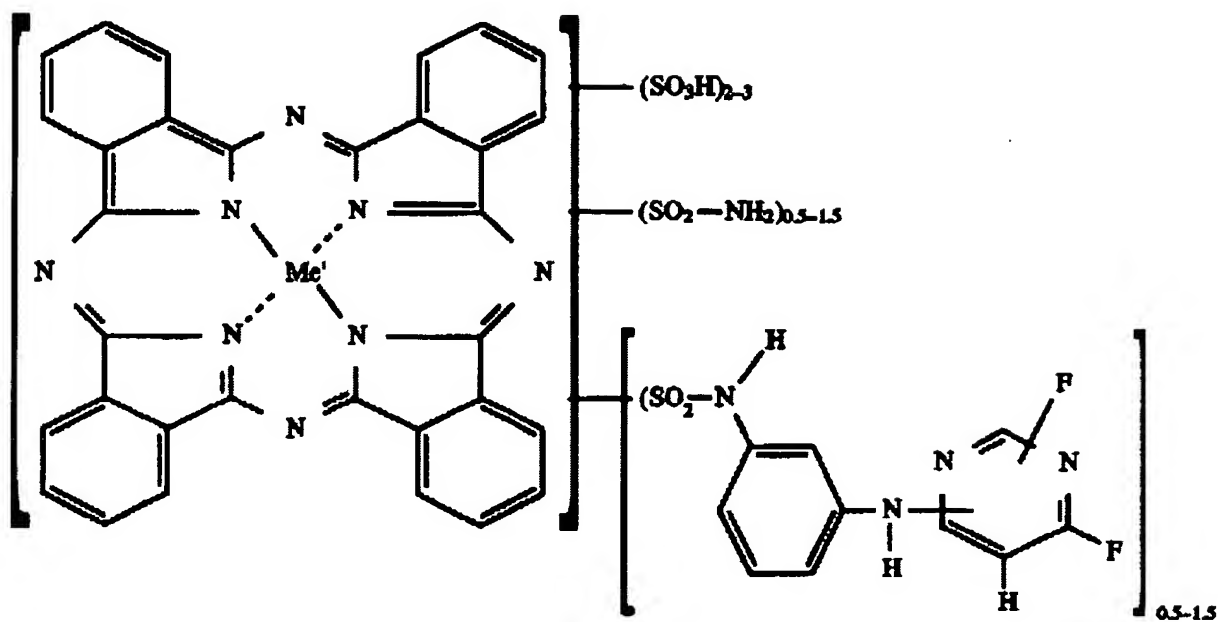
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 5-13, 17, 18, 20-22, 25, 29, 33, 35 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Reddig et al. (US 5,709,717).

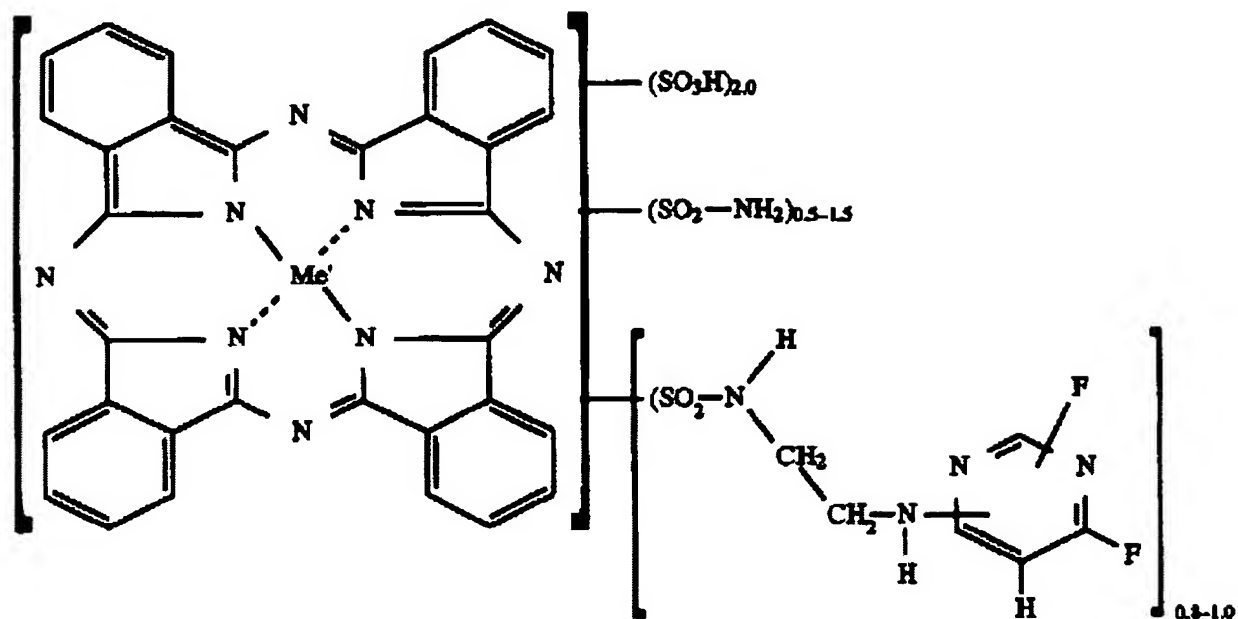
Reddig et al. teach a dyestuff mixture of at least two phthalocyanine reactive dyestuff which contain a different reactive group which comprises at least one chlorine-free phthalocyanine-fluoropyrimidinyl reactive dyestuff of the formula

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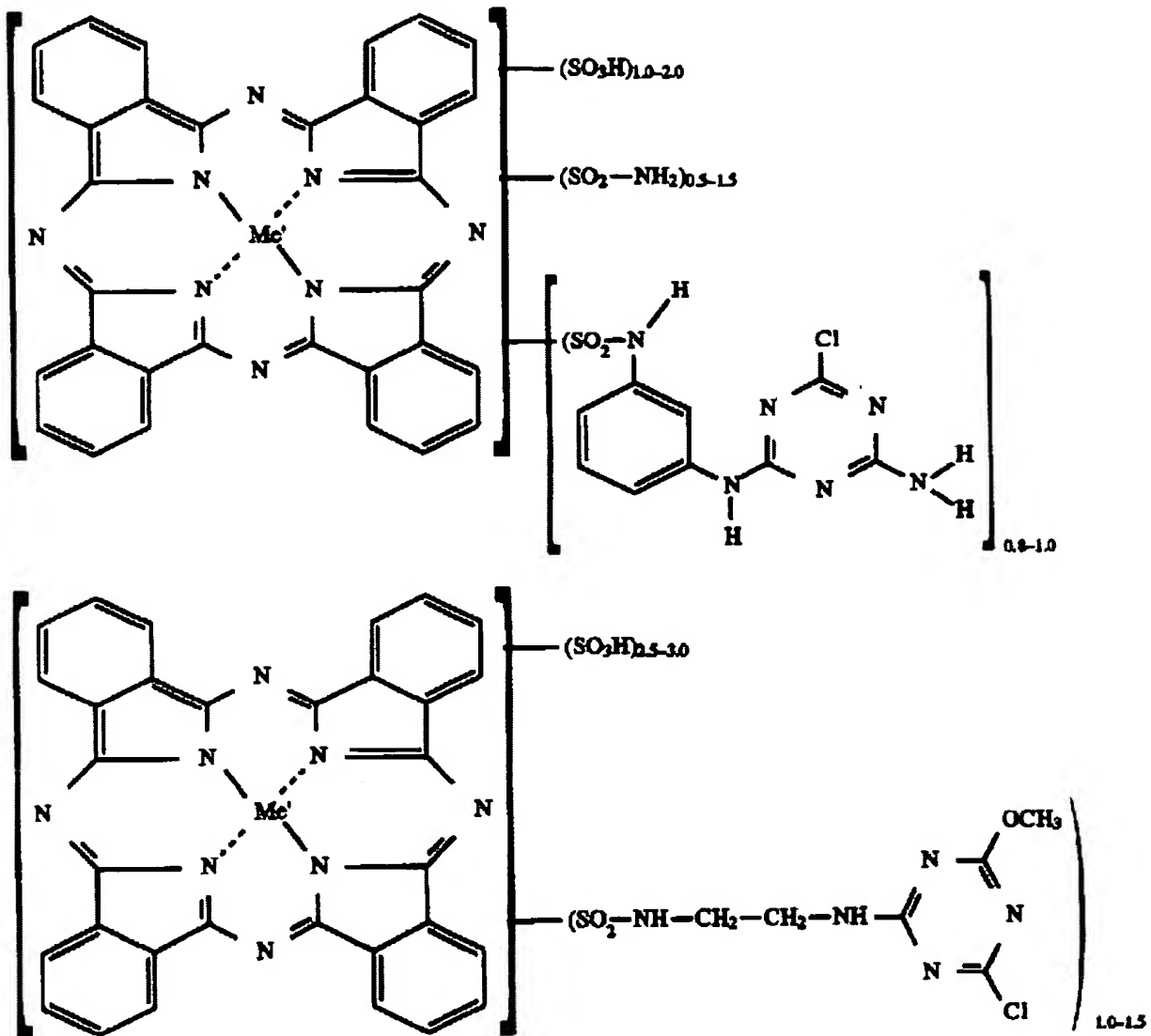


or

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wherein  $Me$  is Ni or Cu and at least one phthalocyanine-monochlorotriazinyl reactive dyestuff of the formula



wherein  $Me$  is  $Ni$  or  $Cu$ . The dye mixtures are suitable for dyeing cotton or other cellulose fibers. See col. 2, lines 49-55, col. 5, lines 1-20, col. 6, line 31 – col. 7, line 59, col. 11, lines 27-31, col. 12, lines 31-50, example 9 and claims 1-4. The dyestuff mixture of at least two phthalocyanine reactive dyestuff as taught by Reddig et al. appears to anticipate the present claims.



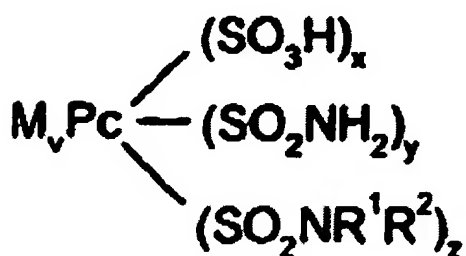
**Claim Rejections - 35 USC § 103**

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 4-16 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1239010.

EP 1239010 teaches compounds of the formula



wherein M represents a metal such as Cu or Ni; Pc represents a phthalocyanine nucleus; R<sup>1</sup> represents H or -(CH<sub>2</sub>)<sub>n</sub>R<sup>3</sup>; R<sup>2</sup> represents -(CH<sub>2</sub>)<sub>n</sub>R<sup>3</sup> or R<sup>1</sup> and R<sup>2</sup> together with the nitrogen atom to which they are attached represent a 5- or 6-membered ring; n is independently an integer from 1-30; R<sup>3</sup> is independently a group selected from hydroxy, sulphy, cyano, -SR<sup>4</sup>, -CO<sub>2</sub>R<sup>5</sup>, -PO<sub>3</sub>H<sub>2</sub> and -NR<sup>6</sup>R<sup>7</sup>; R<sup>4</sup>-R<sup>7</sup> independently represent H, C<sub>1-30</sub> alkyl optionally substituted by one or more groups selected from hydroxy, mercapto, sulphy, carboxy, cyano and -PO<sub>3</sub>H<sub>2</sub>; v is the valence of Pc divided by the valence of M; x is from 1.2-3.8; y is from 0.1-2.7; z is from 0.1-2.7 and x, y and z satisfy 2 ≤ x+y+z ≤ 4. The above formula includes all chemical and physical forms

thereof (i.e.  $\beta$ -substitution). EP 1239010 also teaches an ink jet ink composition comprising 0.01 to 30 parts by weight of at least one of the above phthalocyanine compounds as the colorant (i.e. dye mixture) and 70-99.99 parts by weight of a liquid medium. EP 1239010 further teaches a process for printing comprising ejecting the above ink jet ink composition onto a substrate. See page 2, line 19 – page 3, line 57, page 4, lines 14-27, page 5, lines 27-44, page 7, lines 1-14, examples 1-19, page 12, lines 25-35, Tables I-XI and claims 1-9. EP 1239010 fails to specifically exemplify that the substituents on the phthalocyanine ring are in the  $\beta$ -position or an ink containing a mixture of phthalocyanine dyes as claimed by applicants.

Therefore, it would have been obvious to one having ordinary skill in the art to use the specific  $\beta$ -substituted phthalocyanine dye and an ink containing a mixture of phthalocyanine dyes as claimed by applicants as EP 1239010 also discloses the use of these  $\beta$ -substituted phthalocyanine dyes and mixture of phthalocyanine dyes but fails to show an example incorporating them.

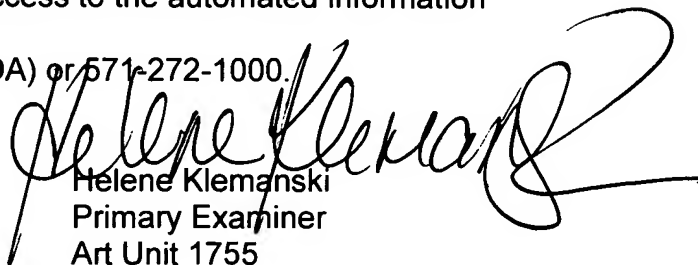
### ***Conclusion***


The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Helene Klemanski  
Primary Examiner  
Art Unit 1755

  
HK  
June 25, 2006